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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,085

02/11/2004

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TAPADI.003C3

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07/10/2008

EXAMINER

BOGART, MICHAEL G

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,085	Applicant(s) TAPADIYA, DILIP	
	Examiner MICHAEL G. BOGART	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 122-126 and 128-133 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 122-126 and 128-133 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

1. The drawings filed 04 June 2007 are informal and are acceptable for examination purposes only.

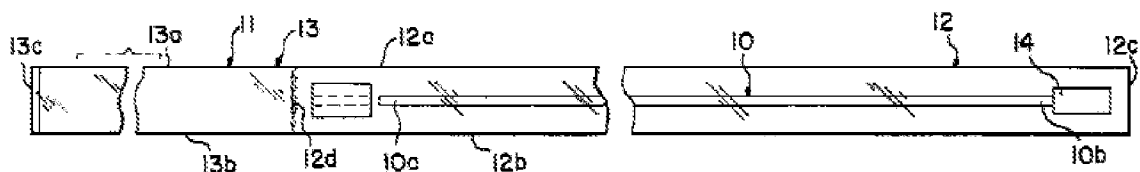
Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

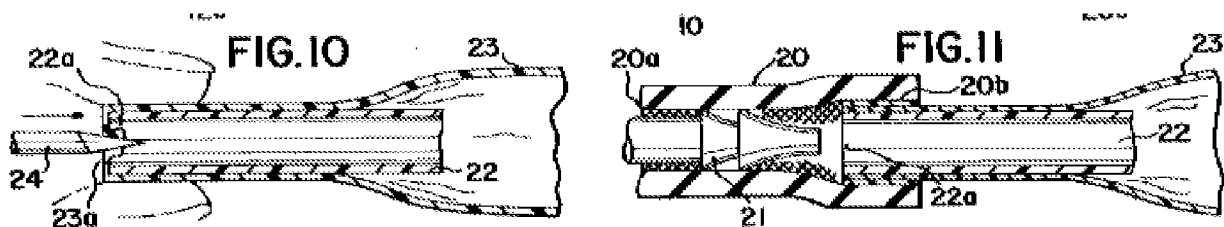
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 122-126, 128, and 130-133 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bryan *et al.* (US 5,582,165 A).

Regarding claim 122, Bryan *et al.* teach a medical kit comprising a sterilized package (12, 23) containing a sterilized length of suction hose (10, 22)(see figures 1, 10 & 11, *infra*).



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Bryan *et al.* do not teach the specifically claimed inner diameter of the suction hose.

Mere changes in the relative size of an element are not sufficient to patentably distinguish a claimed invention over the prior art. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Regarding claim 123, Bryan *et al.* teach a length of suction hose (27) which includes first and second ends, and first (14, 20) and second female (25) adapters connected to the first and second ends, respectively.

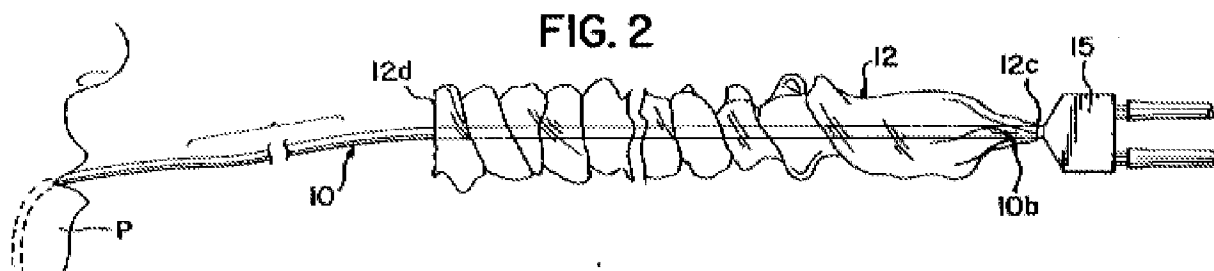
Regarding claims 124 and 128, Bryan *et al.* teach that the first female adapter (14, 20) is configured to be connectable with an outlet of a suction device (10, 20). Regarding the specific diameter, see the discussion of claim 122, *supra*.

Regarding claims 125 and 126, Bryan *et al.* teach that the first connector (20, 21) is connected to a suction device than can be held by hand (10)(see figure 2, *infra*).

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Regarding claim 130, Bryan *et al.* teach that the catheter (10, 22) is a suction hose that is applied for endotracheal suctioning. Structurally, this hose meets all the limitations of the claimed suction hose.

Regarding claims 131-133, Bryan *et al.* teach that the first connector (20, 21) is connected to a suction device (10) that may be held by hand (see figure 2, *infra*).



3. Claim 129 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bryan *et al.* as applied to claims 122-126, 128 and 130-133 above, in view of Giard, Jr. *et al.* (US 2003/0062281 A1).

Bryan *et al.* do not expressly disclose that the suction hose is coiled inside the package.

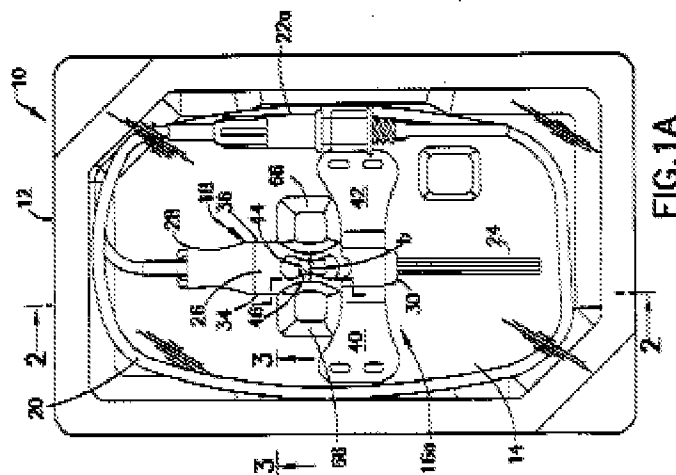
Giard, Jr. *et al.* teach packaging (12) for a medical collection device that includes a coiled tube (20)(see figure 1A, below).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to adopt the coiled tube configuration of Giard, Jr. *et al.* for the kit of Bryan *et al.* in order to provide a compact kit size for storage.

Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a).

Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a).

Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.



Response to Arguments

Applicant's arguments filed 04 June 2007 have been fully considered but they are not persuasive.

4. Applicants assert that Bryan *et al.* do not teach the sterilized suction hose inner diameters and a connector with first and second inner diameters. Regarding the “suction hose” limitation, see col. 1, lines 56-57. Regarding the “sterile” limitation, see col. 2, lines 5-14). Regarding the first and second inner diameters, see the enumerated rejection of claims 122 and 128, *supra*, and figure 11.

5. Regarding the rejection of claims 122-126 and 128-133, applicants assert that the claimed invention would perform differently than that of Bryan *et al.* because this size permits compatibility with operating room hoses. This is not persuasive because this is not evidence that it performs differently, only that is compatible with operating hoses of a certain diameter. Additionally, increasing the size allows for passage of more liquid than a smaller lumen. One of ordinary skill in the art would have recognized the need to size the connector to fit whatever suction source that the device was intended to be used with. How it functions is the same, it connects to a source and allows negative pressure to be applied to the suction hose. The only difference in performance is that larger pieces of material may be passed through the lumen without obstructing it.

It is obvious to apply a known technique (increasing lumen diameter) to a known device ready for improvement to yield predictable results. One of ordinary skill in the art would have recognized that increasing the diameter of a lumen would decrease the chances of particles of a given size passing therethrough from clogging the lumen. The claim would have been obvious

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because increasing the diameter of a lumen designed to have biological liquid possibly containing biological solids pass through it was recognized as part of the ordinary capabilities of one of ordinary skill in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL G. BOGART whose telephone number is (571)272-4933. The examiner can normally be reached on M-F, 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Bogart/
Examiner, Art Unit 3761

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761